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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,675	01/27/2004	Laurence Hubert	D/99398QC	3040

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,675

Applicant(s)

HUBERT ET AL.

Examiner

Maikhanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/27/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/20/04 & 10/18/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the communications: application filed on 01/27/2004.
2. Claims 1-16 are pending in this application. Claims 1, 6, and 11 are independent claims.
3. Acknowledgement is made to the applicant's submission of Information Disclosure Statement, filed 01/27/2004 and 10/18/2004.

Priority

4. Applicant's claim for priority as a continuation application to US application 09/404,174, filed 09/24/1999, now abandoned, is acknowledged.

Specification

5. The cross references related to the application cited in the specification must be updated (i.e., update the relevant status, with PTO serial numbers or patent numbers where appropriate, on page 1). Correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The claimed language “*wherein each time the meta-document is processed during its entire lifetime, processing information pertaining thereto and associated metadata is stored on the meta-document*” (claims 1, 6 and 11) renders the claim indefinite. The meaning of the claim limitation is not clear.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-16 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

- Claims 1-5 are directed to non-statutory subject matter.

For example, independent claim 1 recites:

“A meta-document comprising an object conveying document information, processing information, wherein the processing information comprises information pertaining to processing of the meta-document, and metadata for indexing and retrieving the processing information, wherein each time the meta-document is processed during its entire lifetime, processing information pertaining thereto and associated metadata is stored on the meta-document.”

The claimed *“A meta-document”* does not appear to be tangibly embodied or stored in a computer-readable storage medium. It appears to be a program per se and is not statutory.

Dependent claims 2-5 do not appear to remedy the deficiencies set forth above, therefore, claims 2-5 are rejected for fully incorporating the deficiencies of their base claim.

- Claims 6-10 are directed to non-statutory subject matter.

For example, independent claim 6 recites:

“A method of managing a meta-document comprising: creating a meta-document, wherein the meta-document comprises an object conveying document information, processing information pertaining to processing of the meta-document, and metadata for indexing and retrieving the processing information; processing the meta-document comprising generating and storing on the meta-document processing information pertaining thereto and associated metadata; transmitting

the meta-document to a source; parsing the meta-document for extracting stored processing information and metadata; and wherein each time the meta-document is processed during its entire lifetime, processing information pertaining thereto and associated metadata is stored on the meta-document.”

The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claims is not a tangible result.

Dependent claims 7-10 do not appear to remedy the deficiencies set forth above, therefore, claims 7-10 are rejected for fully incorporating the deficiencies of their base claim.

- Claims 11-16 are directed to non-statutory subject matter.

For example, independent claim 11 recites:

“A system for managing document information comprising a meta-document and a plurality of sources, each source located at a different location, wherein the meta-document comprises an object conveying document information, processing information, wherein the processing information comprises information pertaining to processing of the meta-document, and metadata for indexing and retrieving the processing information, wherein each time the meta-document is processed during its entire lifetime, processing information pertaining thereto and associated

metadata is stored on the meta-document; and wherein each time the meta-document is received by a source, processing information and its associated metadata is parsed and extracted from the meta-document at the source."

The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claims is not a tangible result. Also, claim 11 recites "a system" in the preamble only, the body of the claim merely contains software components. Therefore, the claim is a program per se and not statutory.

Dependent claims 12-16 do not appear to remedy the deficiencies set forth above, therefore, claims 12-16 are rejected for fully incorporating the deficiencies of their base claim.

- The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-10 are rejected under 35 U.S.C. 102(a) as being anticipated by **Applicant Admitted Prior Art (AAPA)**.

As to claim 1:

AAPA teaches a meta-document (*e.g., metadata is stored with the document; see ¶ 0007*) comprising an object conveying document information (*e.g., an object conveying information; see ¶0003*), processing information wherein the processing information comprises information pertaining to processing of the meta-document (*e.g., the information pertaining to word processing-type document manipulations, many documents are moved from site to site or from user to user; see ¶¶ 0005 and 0008*), and metadata for indexing and retrieving the processing information (*e.g., the document will be indexed and described in terms of important keywords Then its URL will be forwarded to a certain number of users with a note to read the important information or knowledge contained in the document; see ¶ 0006*), wherein each time the meta-document is processed during its entire lifetime, processing information pertaining

thereto (*e.g., most of the information about what happened to the document during its whole life 'who read it, review it, where it was sent as an email attachment, who liked it'; see ¶ 0005*) and associated metadata is stored on the meta-document (*e.g., certain additional data called metadata is stored with the document; see ¶0007*).

As to claim 2:

AAPA teaches processing information comprises information pertaining to transformation of the document information (*e.g., many documents are moved from site to site ...information about the document; see ¶0005*).

As to claim 3:

AAPA teaches the processing information comprises a user comment to the document information (*e.g., number of users with a note to read the important information or knowledge contained in the document; see ¶ 0006*).

As to claim 4:

AAPA teaches the processing information comprises information pertaining to distribution of the meta-document (*e.g., many documents are moved from site to site ...information about the document; see ¶0005*).

As to claim 5:

AAPA teaches a tool, embedded on the object, responsive to a processing of the meta-document, for generating and storing processing information (*e.g., a document ...*

information that is created at a given time ... tools ... this information may be stored with the document; see ¶¶ 0003-0004) and associated metadata on the meta-document (e.g., certain additional data called metadata is stored with the document; see ¶0007).

As to claim 6:

The rejection of claim 1 above is incorporated herein in full. Additionally, AAPA teaches transmitting the meta-document to a source (*e.g., when a document is considered important, it is simply duplicated in a large number of copies that are wisely distributed ... the important knowledge contained in the document will be spread throughout the organization; see ¶ 0006*).

As to claim 7:

It includes the same limitations as in claim 5, and is similarly rejected under the same rationale. Additionally, AAPA teaches the parsing step is performed by the tool (*e.g., it may be manipulated by various people and tools; see ¶ 0003*).

As to claim 8:

Refer to the claim 7 above for rejection.

As to claims 9 and 10:

AAPA teaches parsing the meta-document for extracting the selected processing information (*e.g., it may be manipulated by various people and tools; ¶ 0003*), and

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associated metadata (*e.g., certain additional data called metadata is stored with the document; see ¶0007*); and distributing the extracted selected processing information to the source (*e.g., the path of distribution and the fact that a document undergoes changes through its travels add to the knowledge or information ... The use of metadata has also been recognized as having a role in the ongoing management and preservation of digital resources. For example, it has been suggested that metadata could be used for recording the technological context of a resource's origins, for managing and recording rights management information, for preserving the authenticity and reliability of resources as well as for resource discovery; see ¶ 0005 and 0008*).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Applicant Admitted Prior Art (AAPA)** in view of over **MacLean et al.** (U.S. 6,505,219 - filed 01/1999).

As to claim 11:

The rejection of claim 1 above is incorporated herein in full. Additionally, claim 11 recites "*each time the meta-document is received by a source, processing information and its associated metadata is parsed and extracted from the meta-document at the source.*"

AAPA, however, does not specifically teach "*each time the meta-document is received by a source, processing information and its associated metadata is parsed and extracted from the meta-document at the source.*"

MacLean teaches each time the meta-document is received by a source, processing information and its associated metadata is parsed and extracted from the meta-document at the source (*e.g., the relationship between the process description 310 and metadata 312... the relationship between metadata 312 and resources stored in document store 316...use to formulate that task document; col.5, line 55-col.6, line 5*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features from the system of MacLean with APA because it would have provided the capability for user(s) to view the process description

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of a workflow from the perspective of someone who completed a task in the process description.

As to claims 12-14:

They include the same limitations as in claims 2-4, respectively, and are similarly rejected under the same rationale.

As to claims 15-16:

They include the same limitations as in claim 5, and are similarly rejected under the same rationale.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Marchak et al.	U.S. Pat. No. 6,138,104	Issued: Oct. 24, 2000
Gabbita et al.	U.S. Pat. No. 6,349,238	Issued: Feb. 19, 2002
Holmes et al.	U.S. Pat. No. 6,421,700	Issued: Jul. 16, 2002

Contact information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30

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pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN


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